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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,549	06/06/2001	Sho Kuwamoto	07844-001003	6894
21876	7590	12/11/2006	EXAMINER	
FISH & RICHARDSON P.C. P.O. Box 1022 MINNEAPOLIS, MN 55440-1022			TANG, KENNETH	
			ART UNIT	PAPER NUMBER
			2195	

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/875,549	KUWAMOTO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kenneth Tang	2195	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 9,11-13,15,17,18,27,29-31,33 and 35-46 is/are pending in the application.
- 4a) Of the above claim(s) 37-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9,11-13,15,17,18,27,29-31,33,35 and 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This action is in response to the Election filed on 9/25/06 and the Amendment on 6/8/06. Applicant's arguments have been fully considered but are moot in view of the new grounds of rejections.
2. Applicant elects group I (claims 9, 11-13, 15, 17-18, 27, 29-31, 33, and 35-36), which are considered for examination. Claims 37-46 are withdrawn from consideration.

#### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. The claimed invention of claims 9, 11-13, 15, 17-18, 27, 29-31, 33, and 35-36 are directed to non-statutory subject matter. For example, in claims 9 and 27, there is no tangible result: The limitation of locating the identifiers is not a tangible result. The limitation of identifying objects is not a tangible result. The limitation of associating items between the identifiers to an object is not a tangible result. The mere updating or moving data around is an Abstract idea and not statutory. Claims 11-13, 15, 17-18, 29-31, 33, and 35-36 are rejected for the same reasons.

The claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a "useful, concrete and **tangible** result." State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future

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investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966)); In re Fisher, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); In re Ziegler, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had “no substantial practical application.”). “[A]n application of a law of nature or mathematical formula to a ... process may well be deserving of patent protection.” Diehr, 450 U.S. at 187, 209 USPQ at 8 (emphasis added); see also Corning, 56 U.S. (15 How.) at 268, 14 L.Ed. 683 (“It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted . . .”). In other words, the opposite meaning of “tangible” is “abstract.”

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 9, 11-13, 15, 17-18, 27, 29-31, 33, and 35-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

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reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

5. In claims 9 and 27, there is no support in the specification for “identifying a first object associated with at least one of the start identifier and the end identifier, wherein the first object comprises server side code”.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 9 and 27 recite the limitation "the first object" in lines 8 and 10, respectively.

There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 9, 11-12, 15, 17-18, 27, 29-30, 33, and 35-36 are rejected under 35 U.S.C.**

**102(a) as being anticipated by Burd et al. (hereinafter Burd) (US 6,990,653 B1).**

8. As to claim 9, Burd teaches the method of associating information received from a server with a first at least one object, comprising:

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locating a start identifier and an end identifier in the information received from the server, wherein the end identifier corresponds to the start identifier (Fig. 4, items 2, 3, 10, 11, 12, 19, 20, 21, etc.);

identifying a first object associated with at least one of the start identifier and the end identifier, wherein the first object comprises server side code (col. 3, lines 1-40, col. 8, lines 24-57); and

associating an item of information appearing between the start identifier and the end identifier with the first object (the code between the start and end identifiers/tags) (Fig. 4, items 2, 3, 10, 11, 12, 19, 20, 21, col. 8, lines 24-57, etc.).

9. As to claim 11, Burd teaches wherein:

each of the start identifier and the end identifier comprises an object identifier (col. 3, lines 1-40, col. 8, lines 24-57); and

identifying the first object comprises matching the start identifier and the end identifier with a first object identifier (col. 3, lines 1-40, col. 8, lines 24-57).

10. As to claim 12, Burd teaches wherein the start identifier and the end identifier comprise unique identifiers (col. 10, lines 33-50).

11. As to claim 15, Burd teaches:

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locating a special attribute identifier in the information received from the server (col. 10, lines 33-50);

identifying a second object associated with the special attribute identifier (col. 10, lines 33-50); and

associating information corresponding to the special attribute identifier with the second object (col. 10, lines 33-50).

12. As to claim 17, Burd teaches wherein the information corresponding to the special attribute identifier comprises information surrounding the special identifier (col. 10, lines 33-50).

13. As to claim 18, Burd teaches wherein:

the information corresponding to the special attribute identifier comprises a tag (col. 10, lines 33-50); and

the special attribute identifier comprises an attribute of the tag (col. 10, lines 33-50).

14. As to claim 27, it is rejected for the same reasons as stated in the rejection of claim 9.

15. As to claim and 29-30, they are rejected for the same reasons as stated in the rejection of claims and 11-12, respectively.

16. As to claims 33, 35, and 36, they are rejected for the same reasons as stated in the rejection of claims 15, 17, and 18, respectively.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**17. Claims 13 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burd et al. (hereinafter Burd) (US 6,990,653 B1).**

18. As to claim 13, Burd is silent in teaching wherein the start identifier comprises an even number and the end identifier comprises an odd number, wherein the value of the end identifier is greater than the value of the start identifier. However, it would be obvious to compare an even number such as 0 and an odd number such as 1 because it could be used to determine when certain actions are to take place and when they are not to take place, thus increasing the control of the system.

19. As to claim 31, it is rejected for the same reasons as stated in the rejection of claim 13.



***Response to Arguments***

20. Applicant's arguments have been considered but are moot in view of the new grounds of rejections.

21. *Applicant traverses the Restriction as not being proper.*

The claims of Group II refer to copying non-server side code and inserting server side code into a working file, while the claims of group I do not teach this. Therefore, these two groups are distinct. Applicant does not provide any support as to why the inventions are not independent or not distinct. Applicant's arguments are not persuasive.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth Tang whose telephone number is (571) 272-3772. The examiner can normally be reached on 8:30AM - 6:00PM, Every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kt  
12/6/06

  
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